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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/961,425	09/25/2001	Akio Nakashima	2165.11	6616
5514	7590	12/14/2004	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			DICUS, TAMRA	
			ART UNIT	PAPER NUMBER
			1774	

DATE MAILED: 12/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/961,425	NAKASHIMA ET AL.	
	Examiner Tamra L. Dicus	Art Unit 1774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 01 October 2004.  
 2a) This action is **FINAL**.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-9 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-9 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>10-21-04</u> | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-7 stand rejected under 35 U.S.C. 103(a) as being unpatentable over JP 58199185 A (English translation Abstract) to Okawa et al. (JP '185) in view of USPN 4810562 to Okawa et al. as previously set forth in the Office Action mailed 07/01/04.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Response to Arguments***

3. Applicant's arguments filed 10-01-04 have been fully considered but they are not persuasive.

Applicant argues the JP '185 or US '562 do not teach a water repellent layer because the coloring mechanism is not the same as the instant application, specifically, Applicant points to a misunderstanding that "water resistant" is not the same as "water repellent".

Applicant has not made a persuasive argument because JP '185 teaches all the essential materials and layers except for the water repellent layer, and US '562 provides for this layer. JP '185 and US '562 explicitly teach the same coloring mechanism when water is applied, despite Applicant's contentions, the laminate has an image appearing in the same way as Applicant.

Applicant may not have considered the explicit teaching at col. 2, lines 20-54 of US '562

teaching an *opaque* image changeable film comprising a *water-resistant* material in conjunction with an image changeable laminate (water-metachromatic functionality). As to the difference between water resistant and water repellent, because the Applicant has not defined the terms within the specification nor limited the claims to a degree of resisting/repelling property, the Examiner has taken the meaning to be equivalent to the ordinary meaning of these phrases as the dictionary defines them. Both terms are synonymous as “water resistance” as some degree of “water repellence”, see the dictionary reference included. Applicant states the functionality is different because the Okawa references are not concerned with the water repellent layer controlling the transparent nature of the porous resin layer. However, this allegation is not persuasive because JP ‘185 teaches the porous resin layer and all of the ingredients, in combination with the teaching of US ‘562’s “opaque water-resistant” film layer encompassing the same “opaque water-repellent” layer as claimed, the functionality is the same. Applicant does admit that JP ‘185 teaches the concept of providing a porous resin layer and water repellent resin layer when dry is opaque and latent image A is not visible (page 4). Because the same materials are provided, the combination must perform in the same way when water is applied and when water is not applied. Applicant has merely argued, but has not provided any objective evidence to dispute the teachings of the prior art. Applicant argues that the present invention when wet has a porous resin layer portion that does not absorb water where the water repellent resin layer is disposed and remains opaque (ii), however, this is not the same language per se as in instant claim 1. Further, the same opaque water-repellent resin layer is taught by US ‘562, because it is of the same material, thus one would expect the layer to remain opaque and the reference does not teach that the layer does not remain opaque once wet (hence the term “opaque

water-resistant layer" as used by US '562). Applicant teaches the opaque water-repellent resin layer is made of polyethylene (page 13 of specification) and US '562 teaches the same polyethylene material made, resulting in the same opaque water-repellent resin layer (col. 1, lines 57-59 and col. 2, lines 40-43, lines 62-64). See also Table 4 of US '562 teaching that in both the dry and water-absorbed state, color is present. Thus, one having skill in the art can only come to one conclusion: the instant invention is taught in view of the combination of prior art. The rejection is maintained and the request for consideration is denied based off the reasons of record.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamra L. Dicus whose telephone number is 571-272-1519. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Tamra L. Dicus  
Examiner  
Art Unit 1774

12/07/04



RENA DYE  
SUPERVISORY PATENT EXAMINER  
A.U. 1774  
12/10/04